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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,552	04/15/1999	CHARLES L MAURO	9628006999	3736

20583 7590 04/09/2003

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NEW YORK, NY 100362711

EXAMINER

JEANTY, ROMAIN

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/292,552

Applicant(s)

MAURO ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-33,48,49,51,52 and 71-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-33,48,49,51,52 and 71-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to the amendment received on January 17, 2003. No claim has been amended. Claims 81-90 have been added. Claims 8-33, 48-49, 51-52 and 71-90 are now pending in the application and have been examined on the merits.

Response to Amendment

2. Applicant's amendment to the dependent claims 10-11 has overcome the previous objections to these claims. Hence, the objection to claims 10-11 are withdrawn.

Applicant's amendment to the dependent claim 10 has overcome the previous Section 112, second paragraph to the claim. Hence, the rejection to claim 10 is withdrawn.

Response to Arguments

3. Applicant's arguments with respect to claim 1-40 have been considered but are not persuasive.

With regard to applicant's argument that Stokes is not in the same field of endeavor, and does not disclose a computer program for providing trading of financial instruments. The examiner agrees with applicant's argument. However, Stokes was not relying up solely to teach a computer program for providing trading of financial instruments. Minton clearly teaches such a computer program for providing trading of financial instruments. Applicant is directed to col. 3, lines 66 of Minton.

Applicant further argues that Stokes is not "in the same field of endeavor" and is non-analogous art. In response to applicant's argument, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis

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for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Stokes clearly teaches providing real-time quotes on stock and stock options. Note Page 1 second Paragraph. Therefore, Stokes is **not** from a different field of endeavor and is analogous art.

Applicant further argues that Stokes does not provide any capabilities for trading financial instruments. The examiner respectfully disagrees because Stokes does teach the capability to display a variety of opportunities such as stocks (financial instruments), futures and options. Note Page 1 paragraph 5.

a. Applicant further argues that neither Stokes alone nor Stokes in combination with Minton is enabling because Stokes does not enable one skilled in the art of Internet technology to provide real-time stock updates over the Internet.....and there is no suggestion or motivation to combine Minton with Stokes. The examiner respectfully disagrees with applicant's argument in that Stokes does teach real-time streaming of market data. Note Page 1, third paragraph.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to combine Stokes's real-time market data streaming with Minton interactive trading system in order to give traders real edge for buy- and sell decisions.

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Applicant further argues that Tull is directed to an instrument based on an underlying basket of stocks and the price of the instrument is reported to consumers but not the prices of the stocks. The examiner respectfully disagrees because Tull clearly teaches that the current price of bond “instrument”. Note the abstract of Tull.

Applicant further argues that the instrument described in Tull is not on a watch list Nor can the stocks on which the instrument is based be found on a watch list created by the user. The examiner notes that Minton does disclose a watch list “stock watch” for the financial instrument. See figure 4, element 412 of Minton.

Added claims 81-90 recite the similar limitations as the previously rejected claims 71-80; therefore, they are similarly rejected

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Browning (Dialog) discloses “Fidelity Investments Considers Larger Presence in On-line Trading” discloses displaying real-time stock quotes.
- b. Jan (Dialog) discloses automatically updating quotes in real-time.
- c. Dialog (Microsoft: Financing open Windows on Wall Street) automatic update of prices.
- d. Dialog “Fidelity to Roll Out Enhanced Web Offerings” discloses users/traders creating a watch list.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington, D.C 20231
or faxed to: (703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington VA, Seventh floor receptionist.

April 4, 2003

RJ



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600